

Docket No.: 105773.0132
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:
Dante E. PICCONE

Original Patent No.: 5,614,737

Patent No.: RE36770

Original Issue Date: March 25, 1997

Reissued: July 11, 2000

Application No.: 09/273,567

For: MOS-CONTROLLED HIGH-POWER
THYRISTOR

Filed: March 22, 1999

SUPPLEMENTAL RESPONSE TO REQUEST FOR INFORMATION

Commissioner for Patents
Mail Stop Petitions
P.O. Box 1450
Alexandria, VA 22313-1460

Sir:

Further to the response filed November 30, 2009, the present paper is filed in response to the Office Communication mailed September 30, 2009 (hereinafter, "Request for Information"), and in support of the Petition to Accept Unavoidably Delayed Maintenance Fee in an Expired Patent. For clarity, the following papers have been filed to reinstate the above-identified patent:

	DATE	ACTION
1.	9/25/08	Petition to Accept Unavoidably Delayed Maintenance Fee in an Expired Patent
2.	9/30/08	PTO Mailed Notice of Non-Acceptance of Maintenance Fee
3.	12/8/08	PTO Mailed its Decision on Petition
4.	2/9/09	Petition for Reconsideration with Statement from Andrew Yost
5.	2/18/09	Notice of Intent to Supplement Petition for Reconsideration
6.	4/20/09	Notice of Patent Expiration
7.	5/6/09	Supplemental Petition for Reconsideration with Statement by Rebecca South
8.	5/18/09	Notice of Intent to Supplement Petition for Reconsideration
9.	7/7/09	Second Supplemental Petition for Reconsideration with Statement by Peter Weissman
10.	9/30/09	PTO Mailed Request for Information
11.	11/30/09	Response to Request for Information with Statement by Stacey Nalepka

The Petitioner hereby submits a Statement of SueAnne Gill and Statement of Peter S. Weissman (undersigned counsel). Ms. Gill has firsthand knowledge of the docketing procedures and maintenance fee payment procedures during the times in question. In addition, undersigned counsel has information from Mr. Huedell George, who "[p]erformed integrity review and maintenance of all existing, new and transfer client/matter based case files and computerized record information" during the times in question. The Statements are responsive to the information requested by the Office in the Request for Information dated September 30, 2009, as set forth below.

1. **Additional information regarding the Thomson Master Data Center's IP Master docketing software and its use in the industry and why it is a reliable system.**

There is no further information at this time. Kindly see the response filed November 30, 2009.

2. **Explain the process used to enter petitioner's data into the Thomson Master Data Center's IP Master docketing software, more specifically, what data integrity and error checks were used in the process.**

In addition to the response filed November 30, 2009, Ms. Gill's Statement sets forth in detail the process used by the firm to enter data into IPMaster, including data integrity and error checks, during the period of 1994-2008. (See Gill Statement, paragraphs 7-12.)

In general, once a patent issue date was assigned by the PTO, the issue date was input into IPMaster, which calculated the maintenance fee deadlines. In the Petitioner's case, however, the maintenance fee deadlines were (erroneously) entered by the firm's docketing supervisor, Ms. Linda Bynum-Cosby. (See ¶15 and Exhibit B to Gill Statement, having the handwritten initials "LBC" above "Due Date.") As the first docketed deadline approached, the

Maintenance Fee clerk sent a notice to the client that a maintenance fee was coming due. (See Gill Statement, ¶18.) The client's instructions were noted in IPMaster, and payment was made. (See Gill Statement, ¶20.) In preparation for payment of the maintenance fee, the Maintenance Fee clerk was responsible to review the file and resolve any anomalies, inconsistencies or other issues, before the due date was cleared from IPMaster. (See Gill Statement, ¶9.) At that point, the file would generally then be placed with docketing to confirm the action taken, and to update IPMaster to reflect that payment has been made. However, since the firm was between Maintenance Fee clerks at the time (See South Statement, ¶22.), the maintenance fee was paid by the firm's docketing supervisor, Ms. Bynum-Cosby, who was also responsible to update IPMaster.

3. **Explain, in detail, the tests conducted to verify the completeness and reliability of the data entered into the database and provide statements from employees who were involved with the data entry.**

In addition to the response filed November 30, 2009, from December 1999 – June 2001, the firm engaged Mr. Huedell George (with the consulting firm of IP Staffing, Inc.) to conduct an "integrity review and maintenance of all existing, new and transfer client/matter based case files and computerized record information." He reviewed the firm files to ensure that they were properly docketed in the firm's docketing software. When he spotted an issue, he would correct the docketing software. (See Weissman Statement, Ex. A and ¶4d.)

The integrity review is evidence that the firm conducted tests to verify the completeness and reliability of the data entered into the docketing software. Accordingly, it is respectfully submitted that the firm acted reasonably in treating its patent matters as its most important business.

4. Explain how the data entry was accomplished and how the error may have occurred.

As best as can be determined, two clerical errors were committed. The first clerical error occurred in Nov. 2000, when the wrong dates were entered into IPMaster for the maintenance fee deadlines. (See Gill Statement, ¶¶13-27.) That error was committed by Ms. Bynum-Cosby, whose initials "LBC" appear on the Issue Notification just above "Due Date." (See ¶15 and Exhibit B to Gill Statement.) It is likely that Ms. Bynum-Cosby did not think the maintenance fee deadlines should be measured from the date of the underlying '737 patent because the 3.5 year deadline (Sept. 2000) had already passed at that time the deadlines were entered into IPMaster (in Nov. 2000). (See Gill Statement, ¶15.) **In addition, it should be recognized that Reissue and Reexamination proceedings are rather rare, and the PTO procedures are complicated and different than for normal utility patents. Had this been a normal utility patent, and not a reissue patent, it is unlikely that any error would have occurred.** (See Gill Statement, ¶15.)

The second clerical error occurred sometime prior to September 2004, when someone corrected the maintenance fee deadlines (pursuant to the firm's procedure to resolve anomalies when fees come due), but failed to notice that the 3.5 year maintenance fee had not been paid. (See Gill Statement, ¶17.) The firm is unable to tell who corrected the maintenance fee deadlines, because IPMaster does not track that information and the other documents in the file do not identify that person. However, it is likely that the person concluded that IPMaster merely indicated that the wrong fee was due – *i.e.*, the 3.5 year fee, rather than the 7.5 year fee. It is important to note that the docketed date itself was correct (*i.e.*, Sept. 25, 2004). It was only the indication that the "3.5 year fee" (rather than the "7.5 year fee") was due, which was incorrect. Given such an unusual situation, it is certainly understandable that the person would not have

recognized at that time, that the earlier fee had not been paid. (See Gill Statement, ¶20.) In addition, the PTO confirmed receipt of the 7.5 year fee (see Exhibit E to Gill Statement), and the firm never received any notice from the PTO that the 7.5 year fee was not accepted. (See Gill Statement, ¶¶27, 28.)

Accordingly, in Ms. Gill's opinion, the firm's docketing procedures were in accordance with how a reasonable and prudent person would treat its most important business, and that the firm exercised due care and had a reliable and trustworthy system in place to pay maintenance fees. (See Gill Statement, ¶30.)

5. **Affirmatively identify the cause of the error, which would include how the error occurred and who might be responsible for the error, and provide a first hand account of the circumstances relating thereto.**

As recited in response to item 4 above, Ms. Bynum-Cosby appears to have committed the first clerical error.

The second clerical error occurred sometime prior to June 2004, when someone (who cannot be identified based on the information) corrected the maintenance fee deadlines, but failed to notice that the 3.5 year maintenance fee had not been paid. (See Gill Statement, ¶¶21, 22.)

Ms. Bynum-Cosby was the Docketing Supervisor at the times in question. However, Ms. Cosby has not been willing to submit a statement in support of the present petition, for reasons unrelated to the facts of this case. (See Weissman Statement.) Consequently, further details are not available to Petitioner at the present time.

However, Ms. Gill states that Ms. Cosby was very knowledgeable about the patent process and patent docketing procedures, and was very competent in her job. Moreover, she was

"compulsive" in her work and extremely detail-oriented in docketing. "In fact, it was office humor in the docketing department to ridicule one another about being 'obsessive compulsive' in our work." Thus, it is Ms. Gill's opinion that the firm was "reasonable and exercised due care to protect its most important business, including the present patent, by entrusting Ms. Cosby as its head of the docketing department." (See Gill Statement, ¶3.)

6. Address the failure to check with the USPTO to be sure the 3.5-year maintenance fee was timely received, and that the 7.5-year maintenance fee was accepted.

The PTO states that it is reasonable to expect that the Petitioner might routinely check the status of the patent and that the maintenance fee was accepted by the PTO. The Petitioner respectfully submits that the standard for review is whether the steps which were actually taken were reasonable and prudent – and that standard can be satisfied even if the Petitioner had not checked whether the maintenance fee was accepted. Though the Petitioner does not have any information from Ms. Bynum-Cosby (since she is unwilling to provide support in this matter for reasons unrelated to this petition), it seems extremely unlikely that the PTO's statement -- that the "petitioner thought it not reasonable or prudent to check with the USPTO to be sure the 3.5-year maintenance fee was timely received" -- would be true.

Rather, it probably just did not occur to that person to check on the status of the 3.5 year maintenance fee. In hindsight, the PTO may think it would have been reasonable to check on the status of the 3.5 year maintenance fee at that time. However, it is likely that the error was corrected sometime from March-September 2004, which is when reminders would be sent to the client for the improperly-docketed 3.5 year deadline. It is important to keep in mind that the docketed date (*i.e.*, Sept. 25, 2004) was correct. It was only the notation that it was for the 3.5 year fee, rather than the 7.5 year fee, which was incorrect. Thus, at the time the error was

discovered, it would have been natural to assume that the only error was the notation of which fee was due, especially since the date itself (Sept. 25, 2004) was correct.

The Request for Information further notes that Petitioner did not check to see if the 7.5 year maintenance fee was accepted. Based on information and belief, the 7.5 maintenance fee was paid by facsimile within the open period for the payment. Accordingly, there was no reason to expect that the payment would be denied, and therefore no reason to check to see if the payment was not accepted.

As noted in Ms. Gill's Statement (¶27) (also see Ms. South's Statement, ¶25):

27. The 7.5 year maintenance fee was timely paid with sufficient funds in the deposit account. And, the confirmation postcard (Exhibit E, 2nd page) confirmed that the Office received the documents. Thus, in accordance with the firm's procedures, maintenance fee statements and deposit account activity for the subject patent was not monitored. It was believed that the Office accepted payment of the 7.5 year maintenance fee and that the patent remained in force. A letter dated August 27, 2004, and addressed to the patent owner acknowledged receipt of the instructions to pay the 7.5 year maintenance fee and indicated that the fee had been paid or would be paid by the due date. A copy of this letter is attached hereto as Exhibit F.

Given such an unusual situation (of an improperly docketed reissue patent), it is certainly understandable that the person would not have recognized at that time, that the earlier fee had not been paid. In addition, the PTO confirmed receipt of the 7.5 year fee (see Exhibit E to Gill Statement), and the firm never received any notice from the PTO that the 7.5 year fee was not accepted. (See Gill Statement, ¶28.)

Conclusion

The PTO questions how these actions, or inactions, represent the exercise of diligence and prudence. The Petitioner notes that it is not the particular actions and clerical errors which should be examined. The fact that the errors occurred are not in dispute – otherwise, the fee

would have been paid. It clearly was not the firm procedure for Ms. Bynum-Cosby to manually enter the maintenance fee deadline dates, but rather to enter the date the patent issued. And, because the firm was between Maintenance Fee clerks at the time the 7.5 year fee was due, that added layer of backup was missing.

Rather, the proper focus should be on the practices which the firm had in place at the time which are to be examined. As stated in the PTO's Decision dated December 8, 2008, the petitioner must establish that the patent was treated as a reasonable and prudent person would treat his or her most important business. It is important to note that there are many reasonable ways of ensuring that maintenance fee deadlines are met. Because the PTO believes that one process is reasonable (such as checking the 3.5 year fee at the 7.5 year deadline), does not exclude the fact that other processes may also be reasonable.

In that regard, it is clear that the firm was prudent and diligent in protecting its most important business, for at least the following reasons (see Yost Statement, ¶¶5-14 and South Statement, ¶¶7-15):

- The firm had a docketing manager (Ms. Bynum-Cosby) in place who had over 6.5 years of docketing and supervisory experience, including 1.5 years with the firm, and an additional three years of experience as an IP specialist. Others who worked with Ms. Cosby considered her to be knowledgeable, extremely detail oriented and careful, and joked about being "obsessive compulsive" in their work. (See Gill Statement, ¶3.) It was therefore reasonable for the firm to rely on Ms. Bynum-Cosby to properly docket the maintenance fee deadlines, know when the fees are due, and be able to determine when the fees are due. Ms. Gill's opinion is that the firm was "reasonable and exercised due care to protect its most

important business, including the present patent, by entrusting Ms. Cosby as its head of the docketing department.” (See Gill Statement, ¶3.)

- The firm normally had an entire docketing team for entering deadlines into IPMaster, including a Maintenance Fee Clerk who processes all maintenance fee deadlines.
- The Maintenance Fee Clerk was responsible to resolve any anomalies and discrepancies prior to payment of a maintenance fee.
- The Maintenance Fee Clerk kept separate maintenance fee files to streamline and simplify the maintenance fee tracking and payment process.
- The firm had a reliable docketing system from a reputable company, and it docketed (though incorrectly) the maintenance fees in accordance with the firm’s intake procedures, and that docketing system reliably reminded the Petitioner of the docketed deadlines.
- The firm paid the 7.5 year fee and received confirmation from the PTO that the fee was received.
- Accordingly, in Ms. Gill’s opinion, the firm’s docketing procedures were in accordance with how a reasonable and prudent person would treat its most important business, and that the firm exercised due care and had a reliable and trustworthy system in place to pay maintenance fees. (See Gill Statement, ¶30.)
- The firm hired an independent consulting firm to verify the integrity of its patent files. (See Weissman Statement, ¶4d.)

The present situation was a result of internal firm actions. The firm did not mishandle a PTO communication (other than the Reissue patent itself) because the PTO apparently did not send any notice indicating a problem with the maintenance fees or expiration of the patent. The PTO did not intend for every clerical error to result in expiration of a patent, since it allows for a patent to be revived where the petitioner acts in accordance with a reasonable and prudent person. Thus, while it is impossible to account for all human error, it is respectfully submitted that the firm has put in place reasonable measures to protect its most important business. The firm implemented a reliable and trustworthy tracking system to keep track of the relevant dates, and took steps to ensure that the patent information was correctly entered into the docketing system, including the use of an experienced docketing manager.

Request for Interview

In the event the Office has any questions or is inclined to deny this Supplemental Petition for Rehearing, undersigned counsel requests an interview with the Petitions Attorney to identify any issues that the Office may consider to not be met by the present Response.

Request for File

The Petitioner further notes that it has attempted to obtain a copy of the file history at the PTO to see if any additional facts can be ascertained. However, the file history is not currently available because it is with the Petitions Office. In the event the PTO intends to deny the Petition, it is respectfully requested that it release the file so that the Petitioner can gain access to its contents, and that an additional response time be provided by which Petitioner can file another supplemental response.

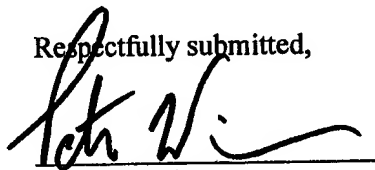
Deposit Account

The Request for Information indicates that no fee is due with the present response. The undersigned hereby reaffirms earlier authorization and request to the Office to charge any outstanding petition fees, maintenance fees, and surcharges to Deposit Account No. 23-2185 necessary to restore this patent to granted status. Authorization to charge the 11.5 year maintenance fee to Deposit Account No. 23-2185 was originally provided on September 25, 2008.

For the reasons set forth above, Petitioner respectfully requests reconsideration of the Decision on Petition.

Dated: June 8, 2010

Respectfully submitted,



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